REMARKS

Applicant appreciates the Examiner's withdrawal of the previous rejections under 35 U.S.C. § 112, first paragraph. Claims 1-27 remain pending in the application, and all stand rejected under 35 U.S.C. 103(a). Specifically, claims 1-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bright (US 4,761,232) in view of Coombes et al. (US 5,290,494). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

No motivation to combine the cited references.

"The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc., v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ 2d 1443 (Fed. Cir. 1992).

Applying these well-established legal principals to the prior art applied in this application, Bright teaches that a synthetic resin material which is to become a microporous matrix is mixed with a water soluble polymeric pore former in a solvent. After extraction of the pore former, the microporous matrix is formed (see column 2, lines 33-64). Thus, it is clear that the formation of the microporous matrix is related to the extraction of the polymeric pore former.

In contrast, Coombes teaches that a single polymer is dissolved in a solvent to form a polymer solution. After the polymer solution forms a gel, the solvent is extracted such that the polymer precipitates to form a microporous material (see column 5, lines 53-65). Thus, it is clear that the formation of the microporous material is related to the extraction of the solvent.

In this regard, there is actually a teaching away form the combination of Bright and Coombes. The mere fact that a reference teaches away from the combination with another reference is sufficient to defeat an obviousness claim. *See Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383. A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Clearly, there is no motivation to combine the cited references due to different methods of forming porous material taught by Bright and Coombes. In fact, the only motivation alleged by the Office Action was that "Coombes et al have demonstrated the usefulness of forming porous structures from a bioresorbable polymer." (Office Action, p. 2). Considered in the context of the clear

disparate teachings of these two references, it is clear that the combination of Coombes with Brights is improper.

For at least the foregoing reasons, Applicant respectfully requests reconsideration of the rejection of independent claim 1. As claims 2-26 depend from claim 1, these claims are also allowable.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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